REMARKS

In the Office Action dated October 18, 2004, claims 1-7, 9, 10, 15-18, 20, 25-28, 30, 36, 37 and 42-44 were indicated as rejected, claims 39-41 were objected to, and claims 11-14 and 38 were indicated as being allowable.

Applicants thank the Examiner for indicating claims 11-14 and 38 as being allowable, but respectfully traverses the Examiner's rejections below. Claims 39-41 have been canceled (without prejudice) rendering the Examiner's objections moot.

Accordingly, claims 1-7, 9-18, 20, 25-28, 30, 36-38, and 42-44 remain pending for examination.

Claims 1-7, 9-10, 15-18, 20, 25-28, 30, 36-37 and 42-44 were rejected under 35 USC 103(a) as being unpatentable over Nordgren, in view of Hey (USP 4,996,642). Applicant respectfully traverses the Examiner's rejections.

It is well settled that for a prior art reference to be an eligible reference, the reference must be enabling for one of ordinary skill in the art, for which the reference is used. Nordgren disclosed a method for outputting recommendations for video. It merely disclosed that the main menu has buttons to the four main functions, one of which is a Recommends button. On selection, a jukebox panel is presented, through which a user can "select three favorite movies". Further, on selection of the three favorite movies, a user will be asked to further select those movies the user "really like". Then, a final list of recommendations will be presented. [Paragraph 6-8.]

It is not clear what is the difference between the "favorite" movies and the movies the user "really like". When the user selects merely "three" favorite movies, aren't these movies the user "really like", since only three selections are provided. Are the "really like" movies a subset or a superset of the "favorite" movies. If it is a subset, is the user being asked again to really narrow it down from three to two or one. If it is a super set, how does the system arrive at the super set. Regardless of whether the "really like" movies are a subset or a super set of the "favorite" movies, how are the recommendations generated based on the "really like" movies. Nordgren is completely silent on these issues.

Thus, Applicants submit Nordgren is not an enabling reference. Accordingly, Nordgren is not an eligible reference.

Even if we are to ignore the non-enabling of Nordgren's teachings, it is well settled that for obviousness rejections, the Examiner is to

- determine the difference between what is claimed and what is taught by the reference;
- identify those of ordinary skill in art; and
- determine whether those of ordinary skill in art would be motivated and capable of modifying the references to arrive at the invention claimed.

Here, since Nordgren has provided no teachings on how the recommendations are generated, and each of the pending independent claims include specific elements for generating the recommendation, Applicants submit the Examiner is unable to perform the required difference determination, and therefore unable to perform the proper obviousness analysis required by law. Without such proper analysis, the rejections are improper.

Further, even if we are to ignore the foregoing discussions, claim 1 specifically requires

> *comparing at least a subset of the user preferences against the plurality of datafiles in the database to identify matching datafiles, each matching datafile containing preferences matching at least a threshold number of the indicated user preferences;*

The required "comparing" operation compares the provided user preferences against a plurality of datafiles to identify matching datafiles. Such a "comparing" is neither inherently required, nor readily suggested from the description of a recommendation process that provides recommendations based on "really like" indications that are provided subsequent to an initial small "favorite" indication.

Thus, Applicants submit Nordgren fails to teach or suggest at least the required "comparing" operation, a deficiency not cured by Hey. Accordingly, claim 1 is not obvious, and patentable over Nordgren and Hey combined.

Claim 9 specifically requires

determining that a number of the preferred music selections match with the plurality of associated music selections in the database;

determining a number of unmatched associated music selections in the database

The limitations require *determining of preferred music selections match with the associated music selections,* as well as *determining unmatched associated music selections.* Such dual *determining* operations against/with a collection of *associated music selections* are neither inherently required, nor readily suggested from the description of a recommendation process that provides recommendations based on "really like" indications that are provided subsequent to an initial small "favorite" indication.

Thus, Applicants submit Nordgren fails to teach or suggest at least the required dual *determining* operations, a deficiency not cured by Hey. Accordingly, claim 9 is not obvious, and patentable over Nordgren and Hey combined.

Claim 10 contains in substance the same limitations as claim 9. Therefore, for at least the same reasons, claim 10 is patentable over Nordgren and Hey combined.

Claim 15 specifically requires

Identify(ing) at least one set of objects having at least a threshold of similarities in common with the first set of objects;

generating a combined set of objects from the identified at least one set of objects;

The limitations require as part of the recommendation generation process, *identifying a (first) set of objects, and then generating a combined set of objects* from *the identified (first) set of objects.* Such a combination of interdependent *object identification and generation* operations is neither inherently required, nor readily suggested from the description of a recommendation process that provides recommendations based on "really like" indications that are provided subsequent to an initial small "favorite" indication.

Thus, Applicants submit Nordgren fails to teach or suggest at least the required combination of *identifying and generating* operations, a deficiency not cured by Hey. Accordingly, claim 15 is not obvious, and patentable over Nordgren and Hey combined.

Claims 25 and 42 contain in substance the same limitations as claim 15. Therefore, for at least the same reasons, claims 25 and 42 are patentable over Nordgren and Hey combined.

Claims 2-7, 16-18, 20, 26-28, 30, 36-37 and 43-44 depend on either claim 1, 9, 10, 15, 25 or 42, incorporating their limitations correspondingly. Accordingly, for at least the same reasons, claims 2-7, 16-18, 20, 26-28, 30, 36-37 and 43-44 are patentable over Nordgren and Hey combined.

Conclusion

In view of the foregoing, claims 1-7, 9-18, 20, 25-28, 30, 36-38 and 42-44 are all in condition of allowance. Early issuance of Notice of Allowance is respectfully requested.

Please charge any fees required for this submission to deposit account 500393.

Respectfully submitted,
Schwabe, Williamson and Wyatt

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Al AuYeung, Reg. No. 35,432
Attorney for Applicant

Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-222-9981